

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name:** State full name (include any former names used).

Grace Stewart Karaffa Obermann
Grace Karaffa Obermann (used professionally)
Grace Stewart Karaffa (maiden name)

2. **Position:** State the position for which you have been nominated.

Judge, U.S. Court of Federal Claims

3. **Address:** List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

Office: U.S. Patent and Trademark Office
Patent Trial and Appeal Board
550 Elizabeth Lane, MDE-09D39
Alexandria, Virginia 22314

Residence: Vienna, Virginia

4. **Birthplace:** State year and place of birth.

1961; Rahway, New Jersey

5. **Education:** List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

1986 – 1989, George Washington University Law School; J.D., with Honors, 1989

1980 – 1984, Rutgers University (Douglass College); B.A., Chemistry, 1984

6. **Employment Record:** List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

2012 – Present
U.S. Patent and Trademark Office
Patent Trial and Appeal Board
550 Elizabeth Lane, MDE-09D39
Alexandria, Virginia 22314
Administrative Patent Judge (2012 – 2013; 2017 – Present)
Vice Chief Judge of Operations (2016 – 2017)
Lead Administrative Patent Judge (2013 – 2016)

2004 – 2012
Davidson Berquist Jackson & Gowdey, LLP
8300 Greensboro Drive, Suite 500
McLean, Virginia 22102
Of Counsel

1991 – 2003
U.S. Department of Justice
Civil Division
Commercial Litigation Branch
Intellectual Property Section
1100 L Street, NW
Washington, DC 20005
Assistant Director (2001 – 2003)
Senior Trial Counsel (2000 – 2001)
Trial Attorney (1991 – 2000)

1998 – 2001
George Washington University Law School
2000 H Street, NW
Washington, DC 20052
Adjunct Professor of Legal Research & Writing

1990 – 1991
U.S. Court of Appeals for the Federal Circuit
Chambers of the Honorable Raymond C. Clevenger, III
717 Madison Place, NW
Washington, DC 20439
Judicial Law Clerk

1989 – 1990; Summer 1988
Fish & Neave
875 Third Avenue, 29th Floor
New York, NY 10022
Associate (1989 – 1990)
Summer Associate (Summer 1988)

Summer 1988
Crowell & Moring
1001 Pennsylvania Avenue, NW
Washington, DC 20004
Summer Associate

Summer 1987
AMTRAK
National Railroad Passenger Corporation
60 Massachusetts Avenue, NE
Washington, DC 20002
Summer Intern, Office of General Counsel

1984 – 1986
FMC Corporation
701 Princeton South Corporate Center
Ewing Township, NJ 08628
Chemist, Research Division

Other Affiliations (Uncompensated):

2007 – Present (estimated)
Andrew Chapel United Methodist Church
1301 Trap Road
Vienna, Virginia 22182
Board of Trustees (2014 – 2015; 2018 – present)
Altar Guild (2007 – 2014) (estimated)
Church Council (2007 – 2012) (estimated)

2004 – 2010 (estimated)
Andrew Chapel Preschool
1301 Trap Road
Vienna, Virginia 22182
Executive Board (Church-Preschool Liaison) (2008 – 2009) (estimated)
Honduran Missions Coordinator (2004 – 2010) (estimated)

1998 – 2007 (estimated)
Georgetown Lutheran Church
1556 Wisconsin Avenue NW
Washington, DC 20007
Grate Patrol Mobile Meal Program Coordinator (1998 – 2007) (estimated)
Altar Guild (1998 – 2001) (estimated)
Church Council (1998 – 2000) (estimated)
Church Treasurer (1999 – 2000) (estimated)

7. **Military Service and Draft Status:** Identify any service in the U.S. Military, including

dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

I have not served in the military. I was not required to register for selective service.

8. **Honors and Awards:** List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

George Washington University Law School

J.D., with Honors, 1989

Member, Law Review (1987 – 1989)

Trustees' Scholarship (1987 – 1989) (based on merit and financial need)

U.S. Department of Justice

Special Achievement Award Recipient (annual monetary award for outstanding achievement); 1995 (estimated), 1996, 1997, 1998, 1999, 2000, 2001, 2002.

Journal Recognition of Achievement in Field

Featured in journal article, "The Brainy Bunch: Meet the men and women shaking up patent law as judges on the Patent Trial and Appeal Board." INTELLECTUAL PROPERTY (An ALM Supplement to CORPORATE COUNSEL) Fall 2015.

Letters of Recognition of Achievement in Field

Solicitor, U.S. Department of the Interior, Mr. John D. Leshy, recognizing achievement in representation of the United States in *Dow Chemical Co. v. United States* (Sept. 25, 2000).

Attorney General, U.S. Department of Justice, Ms. Janet Reno, recognizing achievement in representation of the United States in *Exxon Research & Eng'g v. United States* (June 2, 2000).

General Counsel, U.S. Department of Energy, Ms. Mary Anne Sullivan, recognizing achievement in representation of the United States in *Exxon Research & Eng'g v. United States* (April 7, 2000).

Commander, Portsmouth Naval Shipyard, U.S. Department of the Navy, Captain L.A. Felton, recognizing achievement in representation of the United States in *United States v. Tri-Town Publishers, Inc.* (Mar. 2, 1992).

Circuit Judge, U.S. Court of Appeals for the Federal Circuit, Hon. Raymond C. Clevenger, III, recognizing achievement in service as a judicial law clerk (Sept. 20, 1991).

9. **Bar Associations:** List all bar associations or legal or judicial-related committees,

selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

The Giles Sutherland Rich American Inn of Court
Barrister (1992 – 1998)
Master (1998 – 2001)

The Pauline Newman Intellectual Property American Inn of Court (2013 – present)

The Sedona Conference
Working Group 9 (Patent Damages and Remedies), Informal Judicial Advisor
(2015 – 2017)
Working Group 10 (Patent Litigation Best Practices), Informal Judicial Advisor
(2019)

10. Bar and Court Admission:

- a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

New York Bar (1990)
There has been no lapse in membership.

- b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

U.S. Court of Federal Claims (1992)
U.S. Court of Appeals for the Federal Circuit (1992)
U.S. Court of Appeals for the Fourth Circuit (1997)

There have been no lapses in membership.

11. Memberships:

- a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

The American Association of Patent Judges (2018 – present)

The American Intellectual Property Law Association (2012 – present)

The Association of Former Law Clerks and Technical Assistants of the United States Court of Appeals for the Federal Circuit (1991 – present)

The Cosmos Club, Spousal Member (2019 – present)

The Girl Scouts of the U.S.A.

Troop 1756, Member, Troop Co-Leader, Cookie Sales Manager (2009 – 2016)

Troop 433, Member, Cookie Sales Co-Manager (2016 – 2017)

The Hunter Mill Swim & Racquet Club (2013 – 2017)

The Junior League of Northern Virginia

Member (2004 – 2007)

Cookbook Team, Co-Chair (2004 – 2005)

Children's Events Team, Member (2005 – 2007)

The Network of Executive Women

Member (2016 – present)

Vice Chair (2017 – 2018)

The Pinehurst Country Club, Spousal Member (2001 – present)

The Richard III Society – American Branch (2014 – 2016)

- b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

My understanding is that the Girl Scouts of the U.S.A. limits its membership to girls. My understanding is that the Junior League of Northern Virginia limits its membership to women. My understanding is that the Cosmos Club formerly restricted its membership on the basis of sex, although I understand that any such discrimination ceased many years before I became a member. To the best of my knowledge, no other organization identified above discriminates or formerly discriminated based on race, sex, religion, or national origin through either formal membership requirements or the practical implementation of membership policies.

12. Published Writings and Public Statements:

- a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

None.

- b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

During my time as an informal advisor to the Sedona Conference's Working Group Series, I participated in meetings relating to their papers on "Parallel USPTO Proceedings." Those papers are available online at https://thesedonaconference.org/publication/Parallel_USPTO_Proceedings.

- c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None.

- d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

March 29, 2019: Panelist, "WG10 Commentary on the Evolving Relationship between Federal Courts and Administrative Agencies," The Sedona Conference, Philadelphia, Pennsylvania. PowerPoint supplied.

March 21, 2019: Panelist, "Evolution of PTAB Practice Strategies in Light of Recent Developments," Patent Law Institute, Alexandria, Virginia. Notes supplied.

March 14, 2019: Panelist, "Insights from the PTAB Bench," PTAB Bar

Association, Washington, DC. Notes supplied.

December 6, 2018: Panelist, "Hearsay and Authentication before the Board," U.S. Patent and Trademark Office, presented online. Video available at <https://rev-vbrick.uspto.gov/#/videos/ea0d89ee-0045-4426-bb3d-66d688431c75>.

November 27, 2018: Panelist, "New Claim Construction Standard at the PTAB," American Bar Association, presented online. PowerPoint and notes supplied.

November 13, 2018: Panelist, "Complex PTAB Issues Seen from the PTAB Bench," PTAB Bar Association, Alexandria, Virginia. Notes supplied.

November 20, 2017: Guest Lecturer, Patent Law Class, George Washington University Law School, Washington, DC. PowerPoint supplied.

March 16, 2017: Panelist, "Section 101 and the Future of CBM Reviews before the PTAB," Annual Administrative Law Conference, Washington, DC. I have no notes, transcript, or recording. I spoke about the review of Covered Business Method patents at the PTAB. The address of the Annual Administrative Law Conference is 4300 Nebraska Avenue, NW, Washington, DC 20016.

February 27, 2017: Speaker, "Informal Question and Answer Session with Hon. Grace Karaffa Obermann," The Q. Todd Dickenson Intellectual Property Inn of Court, appeared online to audience in Pittsburgh, Pennsylvania. Notes supplied.

November 7, 2016: Guest Lecturer, Patent Law Class, George Washington University Law School, Washington, DC. PowerPoint supplied.

October 24, 2016: Panelist, "Global Patent Enforcement Strategies," Sedona Conference, Washington, DC. I have no notes, transcript, or recording. I spoke about enforcing patents in domestic and foreign venues. The address of the Sedona Conference is 301 East Bethany Home Road, Suite C-297, Phoenix, Arizona 85012.

September 27, 2016: Panelist, "A History of the PTAB and Overview of IPR, PGR, and CBM Proceedings," U.S. Patent and Trademark Office, Alexandria, Virginia. PowerPoint supplied.

April 18, 2016: Panelist, "State of the PTAB," U.S. Patent and Trademark Office, Alexandria, Virginia. PowerPoint and notes supplied.

April 12, 2016: Panelist, "*Inter Partes* Reviews: Emerging Legal Issues and Challenges," U.S. Patent and Trademark Office, Alexandria, Virginia. PowerPoint and notes supplied.

March 18, 2016: Panelist, "Claim Construction during Post-Grant Proceedings at

the PTAB,” The American Intellectual Property Law Association, Washington, DC. Notes supplied.

March 14, 2016: Panelist, “The Busiest Patent Court in the U.S. – The USPTO’s Patent Trial and Appeal Board (PTAB),” The Patent Law Institute, New York, New York. PowerPoint supplied.

February 12, 2016: Panelist, “Best Practices for USPTO/PTAB Proceedings and Effective Coordination between the USPTO/PTAB and District Court Proceedings,” Sedona Conference, Pasadena, California. I have no notes, transcript, or recording. I discussed best practices for practitioners before the PTAB. The address of the Sedona Conference is 301 East Bethany Home Road, Suite C-297, Phoenix, Arizona 85012.

October 23, 2015: Presenter, “Putting the New PTAB Rules and Regulations into Practice,” The American Intellectual Property Law Association, Washington, DC. PowerPoint supplied.

October 20, 2015: Panelist, “The *Inter Partes* Review (IPR) Process; Purpose; Standing; One Year Bar; and Assignor Estoppel,” Sedona Conference, Reston, Virginia. I have no notes, transcript, or recording. I spoke about improving efficiency in handling patent litigation. The address of the Sedona Conference is 301 East Bethany Home Road, Suite C-297, Phoenix, Arizona 85012.

September 29, 2015: Panelist, “Federal Judicial Panel Discussion: Appeals in Intellectual Property Cases,” Virginia State Bar, Alexandria, Virginia. Notes supplied.

September 16, 2015: Panelist, “Proposed AIA Trial Rules and Single Judge Institution Pilot Program, and Presenter, “Broadest Reasonable Claim Construction Standard,” The Giles Sutherland Rich Inn of Court, Washington, DC. Notes supplied.

August 4, 2015: Moderator, “Ask the Judges,” U.S. Patent and Trademark Office, presented online. Video available at <https://rev-vbrick.uspto.gov/#/videos/28d8e652-9ea0-48b0-831e-271007edd25d>.

July 14, 2015: Moderator, “Discovery in AIA Trials,” U.S. Patent and Trademark Office, presented online. Video available at <https://rev-vbrick.uspto.gov/#/videos/b94c384f-2178-446b-99e2-5594283cf0f7>.

May 12, 2015: Panelist, “PTAB Trials and Their Impact on Litigation,” Federal Circuit Bar Association, presented online. PowerPoint supplied.

March 27, 2015: Panelist, “AIA Trials – Building a Case for Final Hearing,” American Bar Association, Bethesda, Maryland. I have no notes, transcript, or

recording. I spoke about preparing a case for a final hearing. The address of the American Bar Association is 321 North Clark Street, Chicago, Illinois 60654.

March 10, 2015: Panelist, "Patent Session: IPR," Intellectual Property Owners Education Foundation, Washington, DC. I have no notes, transcript, or recording. I discussed costly mistakes that patent prosecutors could make. The address of the Intellectual Property Owners Education Foundation is 1501 M Street, NW #1100, Washington, DC 20005.

January 29, 2015: Panelist, "PTAB Trials: Tips and Strategies," The New York Intellectual Property Lawyers Association, New York, New York. I have no notes, transcript, or recording. I spoke about tips and strategies for trials before the PTAB. The address of the New York Intellectual Property Lawyers Association is 2125 Center Avenue, Suite 406, Fort Lee, New Jersey 07024.

January 23, 2015: Emcee, Investiture of 15 newly appointed Administrative Patent Judges (APJs), U.S. Patent and Trademark Office, Alexandria, Virginia. Notes supplied.

November 13 – 14, 2014: Moderator, "PTAB Family Feud," U.S. Patent and Trademark Office, Pittsburgh, Pennsylvania. PowerPoint and notes supplied.

November 6, 2014: Panelist, "PTAB Practice: Views from All Sides of the Table," The New Jersey Intellectual Property Law Association, New Brunswick, New Jersey. I have no notes, transcript, or recording. I discussed practice before the PTAB. The address of the New Jersey Intellectual Property Law Association is 2125 Center Avenue, Suite 406, Fort Lee, New Jersey, 07024.

October 7, 2014: Panelist, "Views from the PTAB: A Conversation with Honorable Grace K. Obermann," The New Jersey Intellectual Property Law Association, Newark, New Jersey. I have no notes, transcript, or recording. I discussed practice before the PTAB. The address of the New Jersey Intellectual Property Law Association is 2125 Center Avenue, Suite 406, Fort Lee, New Jersey, 07024.

May 6, 2014: Panelist, "Overview of the PTAB," U.S. Patent and Trademark Office, Alexandria, Virginia. PowerPoint supplied.

April 17, 2014: Panelist, "Overview of PTAB Trials, Statistics, and Lessons Learned," and Panelist, "Mock Conference Call before the PTAB," U.S. Patent and Trademark Office, New York, New York. PowerPoint and notes supplied.

April 15, 2014: Panelist, "Overview of PTAB Trials, Statistics, and Lessons Learned," and Panelist, "Mock Conference Call before the PTAB," U.S. Patent and Trademark Office, Alexandria, Virginia. I used the same materials supplied for the April 17, 2014 event above.

March 12, 2014: Panelist, "Lessons Learned: Tips and Strategies for Practicing Before the PTAB," U.S. Patent and Trademark Office, Alexandria, Virginia. Notes supplied.

November 12, 2013: Panelist, "Post-AIA Developments with IPR and CBM Reviews," The New Jersey Intellectual Property Law Association, New Brunswick, New Jersey. PowerPoint supplied.

- e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

Young Artists Exhibit at GRACE, Reston Connection, Mar. 8, 2013. Copy supplied.

I appeared in two TV news broadcasts that aired regionally in Washington D.C. in about 1996 or 1997. In the first TV broadcast, I posed a question to a local sportscaster about the likelihood of a hockey team progressing to compete in a Stanley Cup championship. My best recollection is that the question related to the Pittsburgh Penguins. In the second TV news broadcast, a local news reporter selected me, at random, to provide a review (which was favorable) of The Insect Club, a bug-themed tavern in Washington D.C. I am unable to locate a copy of either TV news broadcast.

13. **Judicial Office:** State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

U.S. Patent and Trademark Office
Patent Trial and Appeal Board
Administrative Patent Judge (2012 – 2013; 2017 – present)
Lead Administrative Patent Judge (2013 – 2016)
Vice Chief Judge of Operations (2016 – 2017)

The Secretary of Commerce appoints Administrative Patent Judges of the Patent Trial and Appeal Board. Sitting in panels composed of three judges (or, in the relatively rare instance of an expanded panel, more than three judges), the Board conducts administrative patent reviews (representing the Board's trial jurisdiction) as well as administrative patent appeals. Adverse final decisions in Board trials and appeals, by statute, are appealable directly to the U.S. Court of Appeals for the Federal Circuit.

The Leahy-Smith America Invents Act of 2011 established the Board's trial jurisdiction, which took effect on September 16, 2012. Congress in that Act newly authorized the Board to conduct four types of administrative patent trials. The first three types (*inter*

partes review, post-grant review, and covered business method review) resolve disputes between patent challengers and patent owners regarding patentability challenges asserted against claims of issued patents. The fourth type (derivation proceedings) resolves multi-party disputes over inventorship.

The Board also hears administrative patent appeals; namely, *ex parte* actions brought by patent applicants seeking relief from adverse decisions of patent examiners. Appeals have been part of the Board's historical jurisdiction for about 150 years.

- a. Approximately how many cases have you presided over that have gone to verdict or judgment?

My best estimate is that I have presided as a panel member over approximately 314 trial proceedings, representing approximately 293 *inter partes* reviews, 17 post-grant reviews, four covered business method reviews, and no derivation proceedings. Approximately 106 of those cases have proceeded to entry of a final written decision (judgment) after trial. An additional 33 trial cases are pending on my docket, approximately 124 additional trial cases have concluded by entry of a detailed, merits-based written determination declining to institute trial, 39 were terminated prior to entry of a final written decision, and eight were dismissed. I also have presided as a panel member over approximately 410 *ex parte* appeals, all of which have proceeded to final decision (judgment).

- i. Of these, approximately what percent were:

jury trials:	0%
bench trials:	100%
civil proceedings:	100%
criminal proceedings:	0%

- b. Provide citations for all opinions you have written, including concurrences and dissents.

See Appendix 13(b).

I have authored two concurring opinions in trial cases. One was entered in connection with the final written decision in *Grünenthal GmbH v. Antecip Bioventures II LLC*, PGR2018-00022, Paper 50 (PTAB Nov. 14, 2018) (Obermann, concurring). The other was entered in connection with the final written decision in *Trans Ova Genetics, LLC v. XY, LLC*, IPR2018-00250, Paper 35 (PTAB June 26, 2019) (Obermann, concurring). I have authored one dissenting opinion, which was entered in connection with the trial institution determination in *Trans Ova Genetics, LLC v. XY, LLC*, IPR2018-00250, Paper 9 (June 27, 2018) (Obermann, dissenting).

- c. For each of the 10 most significant cases over which you presided, provide: (1) a

capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

(1) *Nanya Technology Corp. v. Lone Star Silicon Innovations LLC*, IPR2018-00063, Paper 25, 2019 Pat. App. LEXIS 4831 (PTAB May 15, 2019).

Nanya challenged Lone Star's patent claims covering a semiconductor transistor having "a channel region formed in the semiconductor substrate." The central dispute during the trial was the breadth and scope of that quoted claim phrase. Nanya argued that the phrase broadly encompassed the plain and ordinary meaning of the words in common usage at the time of the invention. Lone Star disagreed, arguing that the inventors narrowed the meaning of the phrase in the written description of the invention provided in the patent. In Lone Star's view, the written description revealed that the disputed claim phrase required a channel region formed during the manufacture of the transistor by implanting channel dopants separate and unique from those employed to dope the semiconductor substrate material. Nanya came forward at trial with persuasive evidence that the challenged patent claims were unpatentable even under Lone Star's narrower proposed construction of the disputed claim phrase. Held: All challenged claims unpatentable.

On July 18, 2019, Lone Star noticed an appeal to the Federal Circuit in this case.

PETITIONER:

Vincent Yip
Peter Wied
NIXON PEABODY LLP
300 South Grand Avenue
Suite 4100
Los Angeles, California 90071
(213) 629-6900

PATENT OWNER:

Timothy Maloney
Nicholas T. Peters
David Gosse
FITCH, EVEN, TABIN, & FLANNERY LLP
120 South LaSalle Street
Suite 2100
Chicago, Illinois 60603
(312) 577-7000

(2) *Grünenthal GmbH v. Antecip Bioventures II LLC*, PGR2018-00001, Paper 48, 2019 WL 1905400 (PTAB Apr. 29, 2019).

Grünenthal challenged the patentability of Antecip's method of treating arthritis by administering a certain bisphosphonate compound – zoledronic acid – having a specified range of bioavailability (that is, the proportion of a drug that enters circulation in the human body and exerts an active effect). A preponderance of the evidence adduced during the trial supported Grünenthal's view that the patent lacked disclosure sufficient to enable an ordinarily skilled artisan to achieve a dosage form of zoledronic acid characterized by the requisite bioavailability. Specifically, the patent challenger established at trial that the steps necessary to determine whether any given dosage form of zoledronic acid would meet the claimed degree of bioavailability would have required approximately one million dollars and a year's worth of effort. Under the circumstances, the patent challenger demonstrated that undue experimentation would have been required to practice the claimed invention. Held: All challenged claims unpatentable.

PETITIONER:

Bruce Haas
Stephen Yam
VENABLE LLP
1290 Avenue of the Americas
New York, New York 10104
(212) 218-2290

PATENT OWNER:

Brent Johnson
Parrish Freeman
MASCHOFF BRENNAN
1389 Center Drive
Suite 300
Park City, Utah 84098
(949) 202-1900

(3) *Multi Packaging Solutions, Inc. v. CPI Card Group Inc.*, IPR2017-01650, Paper 36, 2019 Pat. App. LEXIS 1485 (PTAB Jan. 4, 2019).

Multi Packaging Solutions challenged CPI's patented packaging method for securing a point-of-sale card, such as a gift card, between two paper stock panels fastened together by an adhesive. The patented method required activating the adhesive only in a region substantially surrounding and offset from the item to be secured; namely, the point-of-sale card. Multi Packaging Solutions proved during the trial that a person of ordinary skill in the packaging art would have recognized the benefits and advantages of sealing two paper stock panels together to secure an item within an interior space formed between two panels – without activating adhesive on the item itself. CPI countered that one would not have not have been

led to seal two panels together around the periphery of an item to be secured in a package. CPI's own witness, however, acknowledged that, in the packaging art, the ordinarily skilled artisan would have been aware of thousands of examples of packages sealed all around an item to be secured. Held: All challenged claims unpatentable.

PETITIONER:

Mark Rowland
Gabrielle Higgins
ROPES & GRAY LLP
1900 University Avenue
6th Floor
East Palo Alto, California 94303
(650) 617-4016

PATENT OWNER:

Michael Scheer
THE LAW OFFICE OF MICHAEL J. SCHEER
5531 Murietta Avenue
Sherman Oaks, California 91401
(818) 616-3363

Pejman Sharifi
Louis Campbell
WINSTON & STRAWN LLP
200 Park Avenue
New York, New York 10166
(212) 294-2603

(4) *Argentum Pharmaceuticals LLC v. Alcon Research Ltd.*, IPR2017-01053, Paper 52, 2018 Pat. App. LEXIS 9778 (PTAB Sept. 20, 2018).

The patented invention related to a self-preserved, multi-use ophthalmic composition (in ordinary terms, an eye drop safe for repeated use by a patient over time). The claimed composition was "self-preserved"; that is, preserved without conventional antimicrobial preservatives known to irritate the eye. The patent challenger's position depended on no fewer than six modifications to a formulation disclosed in the asserted prior art references. The Board determined that the challenge was based on impermissible hindsight reconstruction using the patent's disclosure as a guide, rather than a course suggested by the combined teachings of the asserted prior art references. Held: No challenged claim proven unpatentable.

PETITIONER:

Michael R. Houston, Ph.D.
Joseph P. Meara, Ph.D.

James P. McParland, Ph.D.
FOLEY & LARDNER LLP
321 North Clark Street
Suite 2800
Chicago, Illinois 60654
(312) 832-4378

PATENT OWNER:

David Krinsky
Christopher Suarez
WILLIAMS & CONNOLLY LLP
725 12th Street, NW
Washington, DC 20005
(202) 434-5338

(5) *Skechers USA Inc. v. Nike, Inc.*, IPR2017-00620, Paper 79, 2018 WL 3216550 (PTAB June 28, 2018).

Skechers asserted that Nike's patented shoe sole design would have been obvious to a designer of ordinary skill in the art. Taking account of the visual impression of the patented design as a whole, the Board determined that Skechers had entirely overlooked in its petition for review a visually evident feature of the claimed design when formulating its theory of obviousness over a prior art design. As a result, Skechers failed to come forward with evidence at trial sufficient to establish that Nike's shoe sole design was unpatentable over the prior art. Held: No challenged claim proven unpatentable.

PETITIONER:

Samuel K. Lu
Michael R. Fleming
Talin Gordnia
Morgan Chu
IRELL & MANELLA LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, California 90067
(310) 203-7948

PATENT OWNER:

Christopher J. Renk
Erik S. Maurer
Audra Eidem Heinze
Kurt Reister
Michael J. Harris
BANNER & WITCOFF, LTD
71 South Wacker Drive

Suite 3600
Chicago, Illinois 60606
(312) 463-5000

(6) *General Elec. Co. v. United Tech. Corp.*, IPR2016-01289, Paper 25, 2017 Pat. App. LEXIS 12227 (PTAB Dec. 19, 2017), vacated and remanded by *United Tech. Corp. v. General Elec. Co.*, 2019 WL 332754 (Fed. Cir. Jan 25, 2019).

The patented invention relates to an environmental barrier coating for protecting silicon-containing substrates, such as combustor and turbine sections of gas turbine engines. The Board held that General Electric had demonstrated by a preponderance of the evidence that the subject matter of the challenged patent claims would have been obvious at the time of the invention in view of the combined disclosures of the asserted prior art references. On appeal, the U.S. Court of Appeals for the Federal Circuit determined that the Board adopted an overly broad interpretation of the term “bond layer” in the patent claims. The Federal Circuit vacated the Board’s decision and remanded the case for further proceedings consistent with a narrower claim construction. Status: Currently pending before the Board on remand from the Federal Circuit.

PETITIONER:

Anish Desai
Megan Wantland
Brian Ferguson
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, New York 10153
(212) 310-8000

PATENT OWNER:

W. Karl Renner
Timothy Riffe
Lauren Degnan
FISH & RICHARDSON P.C.
1000 Maine Avenue, SW
Washington, DC 20024
(202) 783-5070

(7) *Coalition for Affordable Drugs VI LLC v. Celgene Corp.*, IPR2015-01092, Paper 73, 2017 WL 4014986 (PTAB Sept. 8, 2017), *aff’d Celgene Corp. v. Peter*, 2019 WL 3418549 (Fed. Cir. July 30, 2019).

This case involved a challenge to Celgene’s patented method of delivering a teratogenic drug (that is, a drug known to cause birth defects) to a patient while preventing delivery to a fetus. The patent discussed the history of thalidomide, a drug first synthesized in 1957 and marketed in many countries as a sedative.

Thalidomide was withdrawn from all markets by 1962 after reports of serious birth defects. Thereafter, investigators discovered that thalidomide showed promise as a treatment for cancer, AIDS-related ulcers, macular degeneration, leprosy, and other serious conditions.

Celgene's patented method involved registering patients, prescribers, and pharmacies in a computer readable storage medium and taking a number of steps to ensure that registered pharmacies filled prescriptions for a teratogenic drug only from registered prescribers and only for non-pregnant registered patients. Coalition for Affordable Drugs came forward at trial with persuasive evidence that the combined teachings of the asserted prior art references would have suggested the claimed method. For instance, at the time of the invention, a similar pregnancy prevention program was available for female users of Accutane, a known teratogenic drug and Vitamin A analogue of isotretinoin used to treat severe cases of acne. Held: All challenged claims unpatentable.

The Federal Circuit affirmed the Board's decision in a noteworthy opinion. The Federal Circuit considered, and rejected, patent owner's argument that the retroactive application of the *inter partes* review process to patents issued from applications filed before passage of the Leahy-Smith America Invents Act of 2011 represents an unconstitutional taking under the Fifth Amendment of the Constitution. The Federal Circuit entertained that argument on appeal, notwithstanding that the patent owner did not raise the issue before the Board at the trial level.

PETITIONER:

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(8) *Snap-On Inc. v. Milwaukee Electric Tool Co.*, IPR2015-01242, Paper 91, 2016 Pat. App. LEXIS 13043 (PTAB Nov. 14, 2016), *aff'd* 2018 WL 935454 (Fed. Cir. Feb. 16, 2018).

In a consolidated final written decision, the Board determined that Snap-On failed to establish at trial that any claim of three patents owned by Milwaukee Electric Tool was unpatentable over the asserted prior art references. The claimed invention related to a lithium-based battery pack for a hand-held power tool. At the time of the invention, there was a recognized need in the art for a battery pack capable of powering a tool, untethered to a power cord, by delivering the relatively high discharge current necessary for practical applications. The patent claims specified a battery pack capable of supplying an average discharge current greater than or equal to approximately 20 amps. Snap-on fell short of identifying evidence sufficient to persuade the Board that the combined disclosures of the asserted prior art references would have suggested a battery pack capable of achieving that 20 amp limitation. Held: No challenged claim proven unpatentable. Affirmed by the Federal Circuit.

PETITIONER:

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PATENT OWNER:

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(9) *InnoPharma Licensing, Inc. v. Senju Pharmaceutical Co., Ltd.*, IPR2015-00902, Paper 90, 2016 WL 8944652 (PTAB Jul. 28, 2016).

The patented invention related to an ophthalmic liquid preparation (in common terms, an eye drop) useful for treating conditions of the eye, including conjunctivitis and postoperative inflammation. Specifically, Senju's patent claims covered an aqueous liquid preparation of bromfenac (a non-steroidal anti-inflammatory drug commonly known as an NSAID) as well as tyloxapol in an amount sufficient to stabilize the bromfenac. At the trial institution stage, the Board was persuaded that InnoPharma was likely to show that the invention would have been obvious in view of the combined disclosures of two asserted prior art references. During the course of trial, however, Senju submitted compelling evidence of secondary considerations of non-obviousness, including proof of unexpected results, commercial success, and industry acclaim associated with the claimed invention. For example, Senju established at trial that its commercial product, PROLENSA, embodied the claimed invention and achieved one of the highest shares of prescriptions and revenue among branded drugs with similar indications. The Board found that Senju's objective evidence of non-obviousness outweighed InnoPharma's evidence that the patent claims were unpatentable over the prior art. Held: No challenged claim proven unpatentable.

PETITIONER:

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(10) *ABS Global, Inc. v. XY, LLC*, IPR2014-01161, Paper 26, 2016 Pat. App. LEXIS 810 (PTAB Jan. 11, 2016), *aff'd* 2018 WL 2329812 (Fed. Cir. May 23, 2018).

The patented invention related to a method of discriminating between X- and Y-chromosome-bearing sperm cells to facilitate sex selection in mammalian offspring produced by artificial insemination. The patent claims required collection of "viable sperm cells," and the case turned on the broadest reasonable interpretation of that term. A critical factual issue resolved during the trial was

whether one of the prior art references, in fact, disclosed a method of collecting “viable” sperm cells separated by sex characteristic as specified in the challenged patent claims. That reference disclosed the collection of separated sperm cells used successfully to impregnate up to five cows. The Board rejected XY’s argument that, notwithstanding so many pregnant cows, a question remained whether sperm cells collected by the prior art method were “viable.” Held: All challenged claims unpatentable.

PETITIONER:

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- d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

(1) *Grünenthal GMBH v. Antecip Bioventures II LLC*, PGR2019-00026, Paper 6, 2019 WL 3483282 (PTAB Jul. 30, 2019).

PETITIONER:

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(2) *Intervet Inc. a/k/a Merck Animal Health v. Boehringer Ingelheim Vetmedica, Inc.*, IPR2018-01788, Paper 9, 2019 WL 1751248 (PTAB Apr. 16, 2019).

PETITIONER:

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(3) *Alvogen Pine Brook LLC, v. Celgene Corp.*, IPR2018-01714, Paper 7, 2019 WL 1224681 (PTAB Mar. 14, 2019).

PETITIONER:

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(4) *Dr. Reddy's Laboratories, Inc. v. Celgene Corp.*, IPR2018-01509, Paper 7,
2019 WL 548878 (PTAB Feb. 11, 2019).

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(5) *Levitation Arts, Inc. v. Flyte LLC*, PGR2018-00073, Paper 14, 2019 WL 262706 (PTAB Jan. 17, 2019).

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(6) *Initiative for Medicines, Access & Knowledge (I-MAK), Inc. v. Gilead Pharmaset LLC*, IPR2018-00390, 2018 WL 3493156 (PTAB Jul. 19, 2018).

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(7) *Schlumberger Tech. Corp. v. Enerpol, LLC*, IPR2018-00077, 2018 WL 1989946 (PTAB Apr. 25, 2018).

PETITIONER:

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(8) *ABS Global, Inc. v. XY, LLC*, IPR2017-02184, Paper 10, 2018 WL 1891703 (PTAB Apr. 13, 2018).

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(9) *Teoxane S.A. v. Allergan, PLC, et al.*, IPR2017-01906, Paper 15, 2018 WL 1247018 (PTAB Mar. 9, 2018).

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(10) *KVK-Tech, Inc., Flat Line Capital, LLC v. Silvergate Pharmaceuticals, Inc.*, PGR2017-00039, Paper 8, 2018 WL 792150 (PTAB Feb. 6, 2018).

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- e. Provide a list of all cases in which certiorari was requested or granted.

To my knowledge, none of the cases over which I presided has been the subject of a petition for certiorari.

- f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

General Elec. Co. v. United Tech. Corp., IPR2016-01289, Paper 25, 2017 WL 6517552 (PTAB Dec. 19, 2017), *vacated and remanded*, *United Tech. Corp. v. General Elec. Co.*, 2019 WL 332754 (Fed. Cir. Jan 25, 2019). There, the appellate court vacated and remanded for further proceedings because the Board's decision rested on an incorrect construction of the words "bond layer" as used in the challenged patent claims.

- g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

The Patent Trial and Appeal Board does not designate opinions as published or unpublished. Trial opinions entered by the Board are publicly available (to the extent they are not entered under seal pursuant to a protective order) via the Patents End-to-End Public Portal maintained by the U.S. Patent and Trademark Office. Final opinions are also available on Westlaw and LEXIS.

- h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

To the best of my knowledge, I have issued no significant opinions on federal or state constitutional issues.

- i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

I have not sat by designation on a federal court of appeals.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself *sua sponte*. Identify each such case, and for each provide the following information:

- a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself *sua sponte*;
- b. a brief description of the asserted conflict of interest or other ground for recusal;
- c. the procedure you followed in determining whether or not to recuse yourself;
- d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

My best recollection is that no litigant or party has requested my recusal and I have never recused myself *sua sponte* to remove a real, apparent, or asserted conflict of interest or to cure any other ground for recusal. The Patent Trial and Appeal Board's Standard Operating Procedure 1 lays out the procedures in place for avoiding conflicts of interest in assigning judges to panels. As explained in Section III.B of Standing Operating Procedure 1 (Revision 15), a designee of the Chief Judge of the Board, without my knowledge, may have taken account of my past self-reported conflicts when making panel assignments. Currently, I have no self-reported conflicts.

15. **Public Office, Political Activities and Affiliations:**

- a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

1979 – 1983 (estimated)
Middlesex County Republican Committeewoman (elected)
New Jersey Republican Committee

I have had no unsuccessful candidacies for elective office or unsuccessful nominations for appointed office.

- b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

Other than my service as a Middlesex County Republican Committeewoman, which to the best of my recollection occurred during my last year of high school and first three years of college (1979 – 1983 (estimated)), I have not held membership or office in any political party or election committee. Nor have I held a position or played a role in any political campaign. My best recollection is that, as a Middlesex County Republican Committeewoman, my main function was attending and voting in local and county conventions to nominate political candidates to the Republican Party ticket.

16. **Legal Career:** Answer each part separately.

- a. Describe chronologically your law practice and legal experience after graduation from law school including:

- i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I served as a judicial law clerk to the Honorable Raymond C. Clevenger, III, of the U.S. Court of Appeals for the Federal Circuit (1990 – 1991).

- ii. whether you practiced alone, and if so, the addresses and dates;

I have never practiced alone.

- iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

1989 – 1990
Fish & Neave
875 Third Avenue, 29th Floor
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Associate

1991 – 2003
U.S. Department of Justice
Civil Division
Commercial Litigation Branch
Intellectual Property Section
1100 L Street, NW
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Assistant Director (2001 – 2003)
Senior Trial Counsel (2000 – 2001)
Trial Attorney (1991 – 2000)

2004 – 2012
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Of Counsel

2012 – Present
U.S. Patent and Trademark Office
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Administrative Patent Judge (2012 – 2013; 2017 – Present)
Vice Chief Judge of Operations (2016 – 2017)
Lead Administrative Patent Judge (2013 – 2016)

- iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have never served as a mediator or arbitrator in alternative dispute resolution proceedings.

b. Describe:

- i. the general character of your law practice and indicate by date when its character has changed over the years.

Prior to my clerkship, I was a first year associate with Fish & Neave in New York City (1989 – 1990). During that period, the majority of my

work centered on legal tasks pertaining to patent and trademark litigation filed in federal district court and the U.S. International Trade Commission.

Prior to joining the Justice Department, I served as a judicial law clerk to the Honorable Raymond C. Clevenger, III, of the U.S. Court of Appeals for the Federal Circuit. In that capacity, I assisted in the disposition of over 100 appeals, including many from the U.S. Court of Federal Claims.

During the entirety of my tenure with the Department of Justice (1991 – 2003), I was lead counsel on patent, copyright, and trademark trial cases filed in the U.S. Court of Federal Claims and federal district courts. I also briefed and argued appeals before the U.S. Court of Appeals for the Federal Circuit. In addition, I provided comprehensive legal advice on intellectual property matters to federal agencies and the Office of the White House. As Senior Trial Counsel (2000 – 2001) and Assistant Director (2001 – 2003), in addition to personally handling litigation, I performed managerial and administrative functions for the Office. For example, as Assistant Director, I supervised the work of the trial attorneys responsible for litigating all intellectual property actions brought by or against the United States in federal courts. The vast majority of those cases were before the U.S. Court of Federal Claims.

During my tenure with Davidson Jackson Berquist and Gowdey, LLP (2004 – 2012), my primary role was supporting lead counsel for the plaintiff in litigation before the U.S. Court of Federal Claims. *See Avocent Redmond Corp. v United States and Rose Electronics*, 85 Fed. Cl. 650 (2009), 85 Fed. Cl. 724 (2009), 93 Fed. Cl. 399 (2010). During that period, however, I worked a very limited schedule and was, in essence, a stay-at-home parent (my children were very young during those years).

In my current position as an Administrative Patent Judge of the Patent Trial and Appeal Board, I preside as a panel member over administrative patent trials and appeals. During about the first 18 months of my tenure (February 2012 through about August 2013), I presided solely over administrative patent appeals. In about September 2013, I shifted to a docket consisting almost exclusively of administrative patent trials. Specifically, after about September 2013, in addition to presiding over a full docket of trial cases, I presided, and continue to preside, over an occasional appeal, usually in connection with mentoring a judge or law clerk of the Board. During my tenure as Vice Chief Judge of Operations (from about December 2016 through about June 2017), my tasks centered on executive, managerial, and administrative functions. I presided over few, if any, cases during that period. During my time as a Lead Judge (from about September 2013 through about December 2016), I carried a full docket of trial cases, presided over an occasional appeal in connection with mentoring duties and, additionally, performed some managerial and

administrative functions for the Board.

- ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

During my time in private practice (1989 – 1990; 2004 – 2012), I worked primarily on patent infringement cases in which my law firms represented primarily patent owners (individuals and corporations).

During my tenure at the Justice Department (1991 – 2003), I exclusively represented the United States in patent, copyright, and trademark infringement lawsuits in federal courts. I represented the United States most often as a defendant, but occasionally as a plaintiff, in those lawsuits.

- c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

Essentially all of my practice since graduating from law school has been in litigation.

As an associate with Fish & Neave (1989 – 1990), I supported lead counsel in preparing for, and conducting, a two-week patent infringement jury trial in district court relating to a patented medical device known as a triple-lumen catheter. *See Howes v. Medical Components, Inc.*, 741 F. Supp. 528 (E.D. Pa. June 1, 1990), 761 F. Supp. 1193 (E.D. Pa. Dec. 14, 1990). Also during my tenure at that firm, I supported lead counsel in a one-day trademark trial proceeding before the U.S. International Trade Commission, involving the importation of allegedly counterfeit MOVADO watches. I was present in court during the entirety of both proceedings. However, I did not notice an appearance in either case (given that I was a first year associate and had not yet been admitted to any State bar).

As a judicial law clerk for the Honorable Raymond C. Clevenger, III, of the U.S. Court of Appeals for the Federal Circuit (1990 – 1991), I did not notice an appearance for any party. However, I frequently was present in court, attending appellate arguments on all heard cases over which Judge Clevenger presided as a panel member.

During my 12-year tenure with the Intellectual Property Section of the Commercial Litigation Branch of the U.S. Department of Justice Department, Civil Division (1991 – 2003), I served as lead counsel for the United States in a wide array of patent, copyright, and trademark infringement lawsuits. I frequently appeared in court during my tenure with the Justice Department.

I did not appear in person in court during my tenure with Davidson Berquist Jackson & Gowdey, LLP (2004 – 2012). I worked very limited hours and, in practical effect, was a stay-at-home parent during my tenure with that firm.

During the first 18 months of my tenure as an Administrative Patent Judge of the Patent Trial and Appeal Board (February 2012 – about August 2013), I presided solely over administrative patent appeals. The Board decides the majority of appeals on the briefs without a hearing. During that period, I occasionally appeared in court to preside over heard appeals. Since that time, I have continued to issue an occasional opinion in an administrative patent appeal, but always on the briefs without a hearing in court.

Since about September 2013, I have appeared, and continue to appear, frequently in court to preside over final hearings in Board patent trials. In addition, I frequently conduct telephonic conferences with counsel to resolve interlocutory disputes (for example, discovery disputes) that arise during trial proceedings.

i. Indicate the percentage of your practice in:

- | | |
|-----------------------------|------|
| 1. federal courts: | 100% |
| 2. state courts of record: | 0% |
| 3. other courts: | 0% |
| 4. administrative agencies: | 0% |

ii. Indicate the percentage of your practice in:

- | | |
|--------------------------|------|
| 1. civil proceedings: | 100% |
| 2. criminal proceedings: | 0% |

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

My best estimate is that, as lead counsel, I tried to judgment or final decision (rather than settled) no fewer than about 20 cases, including by summary judgment or dismissal. In addition, during my tenure as Assistant Director of the Intellectual Property Section, I supervised, and appeared along with, lead counsel on many more cases that were tried (rather than settled) to judgment or final decision, including by summary judgment or dismissal.

i. What percentage of these trials were:

- | | |
|--------------|------|
| 1. jury: | 0% |
| 2. non-jury: | 100% |

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your

practice.

I was part of the team that prepared the amicus brief filed by the United States in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiko Co.*, 535 U.S. 722 (2002). Brief available at 2001 WL 1025650.

17. **Litigation:** Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

- a. the date of representation;
- b. the name of the court and the name of the judge or judges before whom the case was litigated; and
- c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

(1) *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371 (Fed. Cir. 2001).

I served as lead counsel for the United States in this exceptionally complex and high profile patent infringement lawsuit, closely watched within the oil industry, which was filed in the U.S. Court of Federal Claims. I was assigned to the case (taking over the role as lead counsel) after the matter had been in litigation for approximately one year. As part of my function as lead counsel, I developed close working relationships with representatives of the impacted global community, including Royal Dutch Shell, Chevron, Petroleos de Venezuela, S.A., and South Africa Synthetic Oil Liquid.

As lead counsel for the United States, I was in charge of developing the theories of the case, retaining and developing the testimony of fact and expert witnesses, completing written discovery and document exchanges, taking and defending depositions of witnesses, and preparing briefs and motions. I also presented oral arguments in all court hearings — including a motion for summary judgment (discussed in more detail below) that resulted in entry of a final judgment in favor of the United States. In addition, I briefed and argued the resulting Federal Circuit appeal, which led to a remand to the U.S. Court of Federal Claims. After remand, as lead counsel for the United States, I continued to develop the theories of the case and prepare for trial. Simultaneously, I served as the sole representative for the United States in numerous settlement negotiations (also discussed in more detail below), which, ultimately, led to a resolution of the dispute on terms extraordinarily favorable to the federal government and the impacted global community.

Exxon asserted that the United States (through activities carried out by the U.S. Department of Energy under a government contract with Royal Dutch Shell) infringed two patents directed to methods of synthesizing alternative fuels. In this aggressively litigated case, near the end of discovery and after filing the government's briefs in anticipation of a *Markman* claim construction hearing, I prepared an expedited summary judgment motion addressing whether the patent claims of both asserted patents were invalid as indefinite under 35 U.S.C. § 112. I briefed and argued that motion before the U.S. Court of Federal Claims, which resulted in a grant of summary judgment in favor of the United States on all claims of both asserted patents. Exxon appealed, and I briefed and argued the case before the Federal Circuit on behalf of the United States. That resulted in the noteworthy Federal Circuit opinion, subsequently cited more than 4,400 times, which first articulated the "insolubly ambiguous" test for claim indefiniteness. That test prevailed in patent law for approximately 13 years until taken up by the Supreme Court in *Nautilus, Inc. v Biosig Instruments, Inc.*, 572 U.S. 898 (2014).

After the Federal Circuit remanded the case, I simultaneously handled the remand activity before the U.S. Court of Federal Claims and participated in negotiations that, ultimately, led to a settlement of the dispute. The settlement negotiations were limited to two individuals – Exxon's chief in-house counsel and me. We conferred repeatedly over several months and, in due course, negotiated the terms of a publicly available settlement agreement that resolved the matter (which Exxon previously had valued in open court at approximately \$400,000,000) by a single lump sum payment by the United States of \$2,583.

DURATION OF REPRESENTATION:

1999 – 2002

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Edward J. Damich, U.S. Court of Federal Claims

Circuit Judges Robert H. Mayer, Alan D. Lourie, and William C. Bryson,
U.S. Court of Appeals for the Federal Circuit.

CO-COUNSEL:

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Ken B. Barrett
U.S. Department of Justice
Washington, DC
(202) 514-7223

COUNSEL FOR PLAINTIFF:

Steven Donald Glazer
David Lender

Peter Tu
Elizabeth Weiswasser
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, New York 10153
(212) 310-8000

COUNSEL FOR PLAINTIFF ON APPEAL:

Edward Bruce (deceased)

- (2) *Dow Chemical Co. v. United States*, 226 F.3d 1334 (Fed. Cir. 2000), 57 Fed. Cl. 403 (2003).

I served as lead counsel in the appeal and remand activity in this patent infringement case filed in the U.S. Court of Federal Claims, which implicated a significant issue of contract law. Prior to my involvement, a different government attorney had litigated the action over the course of 17 years. During that 17-year pendency prior to my involvement, the trial court heard a motion for summary judgment, conducted two trials (one on liability and another on damages), and entered a final judgment against the United States of approximately \$87,000,000. That represented the second highest patent damages award ever entered against the federal government.

I was assigned to handle the United States' appeal from that final judgment. Specifically, I prepared the government's briefs and argued the appeal before the U.S. Court of Appeals for the Federal Circuit. After the conclusion of the appeal, I also handled the remand activity for the United States before the U.S. Court of Federal Claims as described below.

The case centered on Dow's allegation that the United States (through the U.S. Bureau of Mines) had infringed patent claims covering a method for backfilling abandoned coal mines to prevent subsidence of overlying land. The Bureau of Mines secured a patent license from Dow and proceeded to backfill abandoned coal mines in the State of Pennsylvania. The Bureau of Mines, however, stopped paying royalties under the license after determining that its method of backfilling fell outside the scope of Dow's patent claims. Thereafter, Dow sued the United States in the U.S. Court of Federal Claims for unpaid royalties allegedly due under the patent license agreement. Subsequently, during the course of the litigation, Dow purported to rescind the license agreement for failure to pay. The trial court (prior to my involvement) awarded Dow infringement-type damages, as opposed to contract damages based on the terms of the negotiated license. The trial court also accepted Dow's view that the circumstances of the case justified infringement-type damages based on a calculated decrease in property values that would have occurred had the backfill-treated lands collapsed due to subsidence.

Assigned to handle the appeal, I assessed the voluminous record (which spanned 17 years of litigation, including two full trials) to identify and cull the strongest issues for appeal, timely prepare the government's appellate briefs, and persuasively argue the case before the Federal Circuit. The resulting Federal Circuit opinion (which was subsequently cited over 900 times) clarified the contract law principle that rescission is, essentially, an equitable doctrine not ordinarily invoked where money damages are adequate to compensate a party to a contract. Significantly, the Federal Circuit also accepted the government's view that the trial court had applied an overly broad construction of a limitation required by the asserted patent claims. The Federal Circuit specifically adopted the narrower construction advanced by the government on appeal; namely, the same construction assigned by the Bureau of Mines in support of its original decision to cease making royalty payments to Dow. The Federal Circuit, on that basis, vacated the damages award (which by then had grown, with interest, to about \$110,000,000) and remanded the case to the trial court for further proceedings consistent with the correct claim construction.

I litigated the remanded trial case before the U.S. Court of Federal Claims, which involved re-briefing and re-arguing the question of infringement under the correct claim construction based on the existing trial record. That activity on remand culminated in entry of final judgment in favor of the United States (no damages). Dow did not appeal that final judgment to the Federal Circuit.

DATES OF REPRESENTATION:

1996 – 2002

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Loren A. Smith, U.S. Court of Federal Claims.

Circuit Judges Giles S. Rich, Arthur J. Gajarsa, and Senior Circuit Judge Glenn L. Archer, Jr., U.S. Court of Appeals for the Federal Circuit.

COUNSEL FOR PLAINTIFF:

Arthur M. Leiberman (deceased)

- (3) *Global Mail Ltd v. United States Postal Service*, 1:96-cv-01644 (E.D. Va.), 142 F.3d 208 (4th Cir. 1998).

I served as lead counsel (admitted *pro hac vice*) for the U.S. Postal Service in this trademark infringement action filed in the U.S. District Court for the Eastern District of Virginia. I handled the trial-level case as lead counsel from receipt of the complaint through its resolution by settlement. As lead counsel, I was in charge of all litigation tasks, including developing the theories of the case, conducting all discovery, identifying and developing the testimony of fact and

expert witnesses, preparing briefs and motions, and presenting arguments in court. As explained below, attorneys of the Civil Appellate Division of the Justice Department handled the appeal before the U.S. Court of Appeals for the Fourth Circuit. I resumed my role as lead counsel upon remand back to the district court.

Global Mail was a private mail carrier that asserted this trademark infringement lawsuit, seeking monetary and injunctive relief based on the Postal Service's Global Priority Mail products. Specifically, the plaintiff alleged that those products infringed a registered GLOBAL MAIL trademark. I prepared a motion to dismiss based on a theory that the United States, as sovereign, was immune from suit for trademark infringement claims under the Lanham Act. The district court granted that motion. Global Mail appealed to the U.S. Court of Appeals for the Fourth Circuit. The Civil Appellate Division of the Justice Department represented the government's interests during that appeal. The Fourth Circuit reversed, declining to follow an Eighth Circuit decision (discussed below as Item (4) of my answer to this subpart).

On remand, the case returned to me as lead counsel. I litigated the case through fact and expert discovery and the filing of pre-trial motions. That activity crystallized the issues — including the risk of injunction against the Postal Service's worldwide distribution of Global Priority Mail products — and, thereby, facilitated a settlement. I was the sole Justice Department attorney who collaborated with the General Counsel of the U.S. Postal Service and principals of plaintiff to negotiate the terms of the settlement agreement.

DATES OF REPRESENTATION:

1996 – 1998

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Senior District Judge Albert V. Bryan, Jr., U.S. Court of Appeals for the Eastern District of Virginia.

CO-COUNSEL:

Arthur Peabody, Jr.
U.S. Attorney's Office
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Alexandria, Virginia 22314
(703) 299-3700

COUNSEL FOR PLAINTIFF:

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ODIN, FELDMAN & PITTLEMAN, PC
1775 Wiehle Avenue, Suite 400

Reston, Virginia 20190
(703) 218-2100

- (4) *Preferred Risk Mutual Ins. Co., v. United States*, 4:93-cv-10393 (S.D. Iowa), 86 F.3d 789 (8th Cir. 1996), *cert. denied*, 117 S.Ct. 1245 (1997).

I served as lead counsel (admitted *pro hac vice*) for the United States in this trademark infringement action conducted before the U.S. District Court for the Southern District of Iowa. As lead counsel, I was in charge of all litigation tasks at the trial level from receipt of the complaint through final judgment. The Civil Appellate Division of the Justice Department handled the appeal to the U.S. Court of Appeals for the Eighth Circuit.

The United States, through activity of the Federal Emergency Management Agency, administered a national flood insurance program. The words "Preferred Risk" appeared on some applications for insurance administered under that program. Specifically, in areas with lower risks of flooding, the words "preferred risk" indicated an eligibility for lower premiums. The Preferred Risk Mutual Insurance Company of Iowa filed a complaint seeking to enforce its registered PREFERRED RISK trademark against the United States through a writ of prohibitory or mandatory injunction. The company did not seek money damages.

In my capacity as lead counsel, I prepared, filed, and argued a motion to dismiss based on a theory that the United States, as sovereign, was immune from suit for trademark infringement under the Lanham Act. The district court denied that motion, held that FEMA's activity infringed the plaintiff's registered trademark, and enjoined the federal agency's use of the words "Preferred Risk" in connection with its flood insurance applications. The U.S. Court of Appeals for the Eighth Circuit reversed and vacated the district court's judgment. The Civil Appellate Division of the Justice Department represented the United States on appeal.

DATES OF REPRESENTATION:

1993 – 1998

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Ronald E. Longstaff, U.S. District Court for the Southern District of Iowa.

CO-COUNSEL:

John E. Beamer
U.S. Attorney's Office
110 East Court Avenue, Suite 286
Des Moines, Iowa 50309
515-473-9300

COUNSEL FOR PLAINTIFF:

Edmund J. Sease (1995 – 1997)
Heidi E. Sease (1995 – 1997)
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801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
515-288-3667

H. Robert Henderson (1993 – 1997)
Sean Suiter (1994)
HENDERSON & STRUM
1125 South 103 Road, Suite 330
Omaha, Nebraska 68124-1076
402-496-0300

- (5) *Zacharin v. United States*, 213 F.3d 1366 (Fed. Cir. 2000), 43 Fed. Cl. 185 (1999), 108 F.3d 1391 (Fed. Cir. 1997), 34 Fed. Cl. 609 (1996).

I served as lead counsel for the United States throughout the pendency of this patent case filed in the U.S. Court of Federal Claims. As lead counsel, I was in charge of all litigation tasks from receipt of the complaint through, ultimately, final judgment in favor of the government. I developed the theory of the case, identified and developed the testimony of all fact and expert witnesses, conducted all written discovery, defended and conducted all depositions, and briefed and argued a motion for summary judgment before the U.S. Court of Federal Claims. Further, I conducted a one-day trial on the merits, and briefed and argued two appeals before the U.S. Court of Appeals for the Federal Circuit in this case.

The case related to a patented bomb decelerator used by the U.S. Army during Operation Desert Storm. Ultimately, the U.S. Court of Federal Claims entered a final judgment, affirmed by the Federal Circuit, in favor of the United States based on evidence, developed during the trial, that the asserted patent claims were invalid under the on-sale bar provisions of the patent statute.

DATES OF REPRESENTATION:

1993 – 2000

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Lawrence S. Margolis, U.S. Court of Federal Claims

Circuit Judges Paul Michel, Jay Plager, and William Bryson, U.S. Court of Appeals for the Federal Circuit (first and second appeals)

COUNSEL FOR PLAINTIFF:

Judith Bartnoff (1993 – 1994) (currently a Judge of the D.C. Superior Court)
Robert H. Koehler (1994 – 1999)
PATTON, BOGGS, LLP
2550 M Street, NW
Washington, DC 20037
(202) 457-6320

- (6) *John C. Boyle (pro se) v. United States*, 200 F.3d 1369 (Fed. Cir. 2000).

Although this case was litigated *pro se* by Mr. Boyle, it resolved a significant legal issue of first impression, involving the intersection of copyright, trademark, and Fifth Amendment takings law. I served as lead counsel for the United States during the entire pendency of the trial phase before the U.S. Court of Federal Claims and Mr. Boyle's appeal to the U.S. Court of Appeals for the Federal Circuit. As lead counsel, I was in charge of every aspect of the government's defense from receipt of the complaint through entry of final judgment before the U.S. Court of Federal Claims and affirmance on appeal to the Federal Circuit.

For example, I developed the government's theory of the case, prioritized its defenses, conducted discovery (such as document exchanges and witness interviews), and prepared all briefs and papers filed in court. I also drafted the government's brief in connection with Mr. Boyle's appeal (decided without oral argument) to the Federal Circuit.

Mr. Boyle filed a complaint that asserted a Fifth Amendment taking based on the United States' administrative action of registering a federal trademark. But the property allegedly taken consisted of a copyright covered by a federal registration also granted by an administrative action of the United States. Specifically, Mr. Boyle moved for summary judgment on a takings theory, alleging that the government's registration of a non-party's LIFEPATH trademark effectively destroyed Mr. Boyle's federally registered copyright covering a "MONEYFOR" pamphlet, which described mutual fund products. I completed all tasks necessary to defend the United States against that motion. Contemporaneously, I prepared and filed a motion to dismiss the complaint for failure to state a claim upon which relief could be granted. The U.S. Court of Federal Claims denied Mr. Boyle's motion for summary judgment and granted the government's motion to dismiss. Mr. Boyle appealed to the U.S. Court of Appeals for the Federal Circuit. I prepared and filed the brief for the United States before the Federal Circuit, which affirmed, holding that no copyright can be taken by the federal government's lawful issuance of a trademark registration.

DATES OF REPRESENTATION:

1998 – 2000

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Nancy B. Firestone, U.S. Court of Federal Claims

Circuit Judges Jay Plager, Alan D. Lourie, and Raymond C. Clevenger, III, U.S. Court of Appeals for the Federal Circuit.

COUNSEL FOR PLAINTIFF:

Mr. Boyle appeared *pro se*.

- (7) *RT Computer Graphics, Inc. v. United States*, 44 Fed. Cl. 747 (Fed. Cl. 1999).

I served as lead counsel for the United States throughout the pendency of this copyright infringement case from receipt of the complaint through entry of final judgment in favor of the government based on my preparation of a successful motion for summary judgment. As lead counsel for the United States, I developed the government's theory of the case, prioritized its defenses, conducted investigations into the dispositive facts (including witness interviews), conducted discovery, prepared all briefs and papers filed in court, and argued all motions heard by the U.S. Court of Federal Claims.

This copyright infringement lawsuit involved a disputed issue of contract law. The U.S. Court of Federal Claims ruled in favor of the United States, holding that plaintiff, at all relevant times, had consented to the government's use of plaintiff's copyrighted artwork to adorn postage stamps commemorating American Indian Dances. The case turned on the government's successful argument that a requirement to provide plaintiff with authorship credit in promotional materials for the postage stamps was not a condition precedent to plaintiff's consent to the government's use of the copyrighted artwork.

DATES OF REPRESENTATION:

1997 – 2000

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Marian Blank Horn, U.S. Court of Federal Claims

COUNSEL FOR PLAINTIFF:

Paul Adams

Jeffery D. Myers

PEACOCK, MYERS & ADAMS, PC, Suite 1340

Albuquerque, New Mexico 87102

505-242-9677

- (8) *Standard Space Platforms Corp. v. United States*, 38 Fed. Cl. 461 (1997), 35 Fed. Cl. 505 (1996), 35 Fed. Cl. 463 (1996).

I served as lead counsel for the United States throughout the pendency of this litigation before the U.S. Court of Federal Claims. I developed the government's theory of the case, prioritized its defenses, conducted discovery, performed investigations into the dispositive facts (including witness interviews), prepared all briefs and papers filed in court, and argued all motions heard by the U.S. Court of Federal Claims.

In this patent infringement lawsuit, Standard Space Platforms Corporation alleged that spacecraft made for the government infringed two patents owned by the company. I managed an unusually complicated discovery period that included plaintiff's request for an astronomical number of documents, many of which were highly technical and reflected confidential information owned by the government or its contractors. The information sought by plaintiff also contained unclassified technical data, with military or space applications, subject to export controls. I persuaded the trial court that performing an initial review of the tremendous volume of documents responsive to plaintiff's discovery requests would have imposed an undue burden and expense on the government. Specifically, I filed a successful motion that required plaintiff to undertake the initial review of documents, treating them as confidential at the outset, before the United States or its contractors assessed or designated any information as confidential or proprietary. After several years of litigation, plaintiff moved to dismiss the case without prejudice and the United States moved to dismiss the case with prejudice. The trial court denied both motions. Thereafter, I participated in numerous settlement negotiations as the sole representative for the United States. As a result, the parties reach a settlement agreement that resolved the case on terms favorable to the government. Specifically, that agreement required Standard Space Platforms to file a voluntary dismissal of the action without receiving any monetary damages or other relief from the government.

DURATION OF REPRESENTATION:

1994 – 1997

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Reginald W. Gibson, U.S. Court of Federal Claims

COUNSEL FOR PLAINTIFF:

David Bruce Newman, Jr.
Centennial Square
P.O. Box 2728
La Plata, Maryland 20646
301-934-6100

- (9) *Marcel H. Blais, et al., v. United States*, 31 Fed. Cl. 422 (1994).

I served as lead counsel for the United States during the entire pendency of this patent lawsuit, which involved a disputed issue of contract law. As lead counsel, I was in charge of every aspect of the government's defense from receipt of the complaint through entry of final judgment. For example, I developed the theory of the case, conducted all investigations into the dispositive facts (including witness interviews), conducted discovery, prepared all briefs and papers filed in court, and argued all motions heard by the U.S. Court of Federal Claims.

The United States, through the U.S. Air Force, contracted with a construction company to provide and install moveable, stainless steel swimming pool bulkheads at the U.S. Air Force Academy. That contractor subcontracted with a company known as Statewide Pools. Mr. Blais was a co-inventor of a patent directed to swimming pool bulkheads and served, during the relevant time, as a consultant to, or chief executive of, Statewide Pools. After the contractor delivered and installed the bulkheads at the U.S. Air Force Academy, the government paid the contractor in full the agreed purchase price. The contractor, however, went bankrupt before fully paying moneys owed to Statewide Pools under the subcontract. Statewide Pools, in turn, was dissolved through bankruptcy, and Mr. Blais, in his capacity as co-inventor of the patent-at-issue, sued the United States for the outstanding amount of its contract with the government's (now bankrupt) contractor.

I prepared a motion for summary judgment based on the theory of implied license. The U.S. Court of Federal Claims granted the government's motion and, on that basis, entered a final judgment in favor of the United States (no damages).

DURATION OF REPRESENTATION:

1992 – 1994

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Judge Wilkes C. Robinson, U.S. Court of Federal Claims

COUNSEL FOR PLAINTIFF:

James Tilberry
Retired

- (10) *Avocent Redmond Corp. v United States and Rose Electronics*, 85 Fed. Cl. 640 (2009), 85 Fed. Cl. 724 (2009), 93 Fed. Cl. 399 (2010).

I supported lead counsel for plaintiff during the pendency (2008 – 2011) of this patent infringement action brought against the United States based on alleged infringement of patents related to keyboard-video-mouse technology. The United States asserted laches as an affirmative defense. The U.S. Court of Federal

Claims denied the parties' cross-motions for summary judgment on the question of the availability of laches as a defense. Thereafter, the parties entered into a settlement agreement that resolved the case.

DURATION OF REPRESENTATION:

2008 – 2011

JUDGES AND COURTS BEFORE WHOM I APPEARED IN THIS CASE:

Senior Judge Lawrence S. Margolis, U.S. Court of Federal Claims

LEAD COUNSEL FOR PLAINTIFF:

James D. Berquist
DAVIDSON BERQUIST JACKSON & GOWDEY, LLP
8300 Greensboro Drive, Suite 500
McLean, Virginia 22102
571-765-7702

COUNSEL FOR DEFENDANT:

Robert G. Hilton
Commercial Litigation Branch
Civil Division
U.S. Department of Justice
Washington, DC
(202) 307-0346

18. **Legal Activities:** Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

During my 12-year tenure with the Justice Department, a significant portion of my time was devoted to providing legal advice to federal agencies and the Office of the White House on matters that did not progress to litigation. During my 12-year tenure with the Justice Department, I received and resolved, on about a weekly or bi-monthly basis, requests for legal advice from a wide variety of federal agencies pertaining to intellectual property matters that did not lead to litigation.

I have not performed lobbying activities.

19. **Teaching:** What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I was an instructor of legal research and writing for first year law students at George Washington University Law School for three academic years (1998 – 2001). I do not recall creating a syllabus and have not been able to locate one for this teaching assignment.

20. **Deferred Income/ Future Benefits:** List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

The only future benefits I expect to receive are from my own and my husband's federal retirement plans, investments in individual retirement accounts, and investments in retirement accounts acquired by my husband during his former employment by the MITRE Corporation and the National Academy of Sciences.

21. **Outside Commitments During Court Service:** Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

I have no plans, commitments, or agreements that fall within this category.

22. **Sources of Income:** List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding \$500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

When my nomination is formally submitted to the Senate, I will file my mandated Financial Disclosure Report and will supply a copy to this Committee.

23. **Statement of Net Worth:** Please complete the attached financial net worth statement in detail (add schedules as called for).

Please see attached Net Worth Statement.

24. **Potential Conflicts of Interest:**

- a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

I do not foresee any conflicts. However, if confirmed, I would resolve any actual

or potential conflicts of interest in a manner consistent with the Canons of the Code of Conduct for United States Judges, 28 U.S.C. § 455, and all other laws, rules, and court practices governing such situations.

- b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

If confirmed, I would resolve any actual or potential conflicts of interest in a manner consistent with the Canons of the Code of Conduct for United States Judges, 28 U.S.C. § 455, and all other laws, rules, and court practices governing such situations.

25. **Pro Bono Work:** An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

I am a devoted public servant, having dedicated the bulk of my career (about 20 years) to government service. Beginning in law school, I have strived to serve the disadvantaged through volunteer activities, which have included, for example, cleaning homes for low-income elderly adults, preparing and serving meals to homeless individuals, and organizing shoe drives and clothing collections for Honduran children living in poverty. In addition, I have served as a moot court judge on numerous occasions over the years for the Giles Sutherland Rich Memorial Moot Court Competition, which is open to law students throughout the country and focuses on intellectual property law issues.

26. **Selection Process:**

- a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

I did not contact, nor am I aware of, any selection commission in my jurisdiction to recommend candidates for nomination to the federal courts. My best understanding is that, on or about June 24, 2019, a former high school classmate of mine submitted my resume to the Office of White House Counsel. The resume identified, as my sole and specific objective, an appointment to the U.S. Court of Federal Claims. On June 25, 2019, I received a telephone call from the Office of White House Counsel, seeking to schedule an interview. I participated in an

interview on July 3, 2019, attended by attorneys from the Office of White House Counsel and the Justice Department's Office of Legal Policy. My next contact was on July 22, 2019, when I received a telephone call from the Office of White House Counsel, informing me of my selection for further vetting. Since that time, I have had contact with the Office of White House Counsel and the Justice Department's Office of Legal Policy solely to facilitate the vetting process, including a background investigation by the Federal Bureau of Investigation.

- b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

FINANCIAL STATEMENT

NET WORTH

Provide a complete, current financial net worth statement which itemizes in detail all assets (including bank accounts, real estate, securities, trusts, investments, and other financial holdings) all liabilities (including debts, mortgages, loans, and other financial obligations) of yourself, your spouse, and other immediate members of your household.

ASSETS				LIABILITIES			
Cash on hand and in banks		142	000	Notes payable to banks-secured (auto)			
U.S. Government securities			500	Notes payable to banks-unsecured			
Listed securities – see schedule	2	174	800	Notes payable to relatives			
Unlisted securities				Notes payable to others			
Accounts and notes receivable:				Accounts and bills due			
Due from relatives and friends				Unpaid income tax			
Due from others				Other unpaid income and interest			
Doubtful				Real estate mortgages payable – see schedule		411	000
Real estate owned – see schedule	1	672	000	Chattel mortgages and other liens payable			
Real estate mortgages receivable				Other debts-itemize:			
Autos and other personal property		24	800				
Cash value-life insurance							
Other assets itemize:							
Thrift Savings Plan 1		940	000				
Thrift Savings Plan 2	1	751	000				
				Total Liabilities		411	000
				Net Worth	6	294	100
Total Assets	6	705	100	Total Liabilities and Net Worth	6	705	100
CONTINGENT LIABILITIES				GENERAL INFORMATION			
As endorser, comaker or guarantor				Are any assets pledged? (Add schedule)	No		
On leases or contracts				Are you defendant in any suits or legal actions?	No		
Legal Claims				Have you ever taken bankruptcy?	No		
Provision for Federal Income Tax							
Other special debt							

FINANCIAL STATEMENT

NET WORTH SCHEDULES

Listed Securities

Ameritrade IRA Cisco Systems Stock	3,500
Ameritrade IRA Financial Select Sector SPDR Fund	12,200
Ameritrade IRA Real Estate Sector SPDR Fund	2,500
Ameritrade IRA Cash	15,600
MITRE 403(b) Plan A Fidelity Contrafund K6	219,300
MITRE 403(b) Plan A Fidelity Invst Gr Bd	22,100
MITRE 401(a) Plan B1 Fidelity Contrafund Pool	744,000
MITRE 401(a) Plan B1 Fidelity Managed Income Fund	34,700
TIAA Traditional Retirement Annuity (Fixed)	306,400
CREF Money Market Fund	3,700
CREF Stock Fund	442,200
Vanguard IRA 500 Index Fund	12,000
VBS IRA Stock Fund	1,900
Fidelity IRA Contrafund	53,400
Fidelity IRA Midcap Stock Fund	7,300
Fidelity IRA Magellan Fund	114,600
Fidelity IRA Cash	4,300
Vanguard IRA Windsor II Fund	24,000
Vanguard IRA GNMA Fund Investor Share	22,300
Vanguard Total SM Index Fund	9,500
Vanguard 500 Index Fund	7,900
T Rowe Price S&T Fund	13,500
Fidelity Contrafund	7,700
Janus Research Fund	14,100
Janus 40 Fund D	12,800
Janus Overseas Fund	1,100
American Century ULTRA Fund	9,500
Charles Schwab UTMA Morton Capital Managed Funds	52,700
Total Listed Securities	<u>\$2,174,800</u>

Real Estate Owned

Personal Residence	1,280,000
Family Residence (50% interest)	165,000
Rental Property (50% interest)	227,000
Total Real Estate Owned	<u>\$1,672,000</u>

Real Estate Mortgages Payable

Personal Residence – Mortgage	411,000
Total Real Estate Mortgages Payable	<u>\$411,000</u>

AFFIDAVIT

I, Grace K. Obermann,
do swear that the information provided in this statement is, to
the best of my knowledge, true and accurate.

10/2/2019
(DATE)

Grace K. Obermann
(NAME)

Commonwealth of Virginia
County of Fairfax

This instrument was acknowledged before me

on 02 day of October, 2019

By Grace K. Obermann

[Signature]
Notary Public's Signature

(NOTARY)

